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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM R. WELLS, RICHARD WILDER, HAROLD E. MATTICE, and CHANCEY W. GRISWOLD

Appeal 2010-009612
Application 09/491,899[1]
Technology Center 2100

Before ROBERT E. NAPPI, ERIC S. FRAHM, and DAVID M. KOHUT, *Administrative Patent Judges*.

FRAHM, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] An Oral Hearing for this appeal scheduled for May 1, 2012 was waived.

STATEMENT OF CASE[2]

Introduction

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-3, 5, 6, 8-10, 12, 13, and 24-29. Claims 1-7, 11, 14-23, 27, 29, and 30 have been canceled.[3] Accordingly, only claims 8-10, 12, 13, 24-26, and 28 remain on appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' Disclosed Invention

Appellants disclose and claim a gaming method using a portable biometric smart card carried by a player, the card containing financial account information and personal preference data. Biometric data from the card is compared to biometric data measured from a player, and if there is a match then the player is authorized to access his/her account and use a cash balance on the card to play a gaming device (Abs.; Spec. 3:15-4:6; Figs. 1 and 2; claims 8 and 24). Claims 8 and 24 are independent, and each recites a gaming method for a gaming apparatus to be played by a player.

Exemplary Claim

Exemplary independent claim 8 under appeal reads as follows:

> 8. A gaming method for a gaming apparatus to be played by a player comprising:
>
> storing first biometric data for a player in a portable biometric smart card carried by the player, which smart card is carried by the player separate from the gaming apparatus,

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[2] We refer throughout our decision to the Appeal Brief filed October 26, 2007 ("App. Br."), the Examiner's Answer mailed February 6, 2008 ("Ans."), and the Reply Brief filed February 28, 2008 ("Reply Br.").

[3] *See* Advisory Action mailed June 30, 2010; and Appellants' Amendment After Final also filed June 30, 2010.

storing financial account information for the player in said smart card, and also storing personal preference data for said player in said smart card;

providing a gaming terminal;

coupling a reader to said gaming terminal, configured for playing at least a first game, wherein said reader receives said first biometric data stored on said smart card;

measuring biometric data of said player to provide measured biometric data; and

comparing said measured biometric data to said biometric data stored on said smart card; and if there is a match, outputting an authorization allowing the player to access his or her account and/or use a cash balance on the smart card to play the gaming device.

Rejections

(1) The Examiner rejected claims 8, 12, 13, 24, 26, and 28 as being unpatentable under 35 U.S.C. § 103(a) over Orus (US 2004/0035926 A1) and Soltesz (US 2001/0011680 A1). Ans. 7-11.

(2) The Examiner rejected claims 9 and 10 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Orus, Soltesz, and Thompson (US 5,865,470). Ans. 12-13.

(3) The Examiner rejected claim 25 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Orus, Soltesz, and Nakata (US 5,736,727). Ans. 13-14.

Appellants' Contentions

Appellants contend (App. Br. 8; Reply Br. 1-5) that the Examiner erred in rejecting claims 8 and 24 under 35 U.S.C. § 103(a) for numerous reasons including:[4]

(1) Orus and Soltesz fail to disclose storing personal preference data in a smart card, such that "the player's personal preference data . . . need not be stored in a database associated with a gaming machine" (App. Br. 8);

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[4] Appellants provide specific arguments as to claims 8 and 24 (*see* App. Br. 8), and present only general arguments in the brief as to various limitations of the claims on appeal without directing the arguments to any specific claim (*see generally* App. Br. 8-9; Reply Br. 1-5).

Because (i) Appellants' arguments (App. Br. 8-9) are primarily directed to a gaming method using a portable biometric smart card containing personal preference data (as found in claims 8 and 24), and (ii) Appellants present no separate arguments as to claims 12, 13, 26, and 28, we select claim 8 as representative of the group of claims consisting of claims 8, 12, 13, 24, 26, and 28 rejected under 35 U.S.C. § 103(a) over Orus and Soltesz, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii). *See In re McDaniel*, 293 F.3d 1379, 1383 (Fed. Cir. 2002) ("If the brief fails to meet either requirement [of 37 CFR § 1.192(c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.").

Claims 9 and 10 stand separately rejected under 35 U.S.C. § 103(a) over the combination of Orus, Soltesz, and Thompson. Appellants do not provide any arguments as to this rejection other than to rely on the arguments provided as to claim 8. Accordingly, we decide the appeal of this rejection on the same basis as claim 8 from which claims 9 and 10 depend.

Claim 25 stands separately rejected under 35 U.S.C. § 103(a) over the combination of Orus, Soltesz, and Nakata. Appellants do not provide any arguments as to this rejection other than to rely on the arguments provided as to claim 24. Accordingly, we decide the appeal of this rejection on the same basis as claim 24 from which claim 25 depends.

In view of the foregoing, our analysis will only address the merits of representative claim 8.

(2) Orus (¶¶ [0012] and [0018]) fails to teach or suggest personal preference data as disclosed by Appellants in the Specification (*see* Spec. 6, ll. 5-7) as user preference information that indicates types of games, drinks, entertainment, food, smoking/nonsmoking preferences, preferred machine denominations, etc. (App. Br. 8);

(3) Orus's information on a gambler and amount of credit stored are not equivalent to the recited player's personal preference data because Appellants define a gambler's personal preference data in the Specification as types of games, drinks, food, etc. (Reply Br. 4-5);

(4) Orus' smart card is numeric only, and not biometric as required by the claims (Reply Br. 1-2); and

(5) there is no motivation for combining Orus and Soltesz (Reply Br. 2-4).

Principal Issue on Appeal

Based on Appellants' arguments, the following principal issue is presented for appeal:

Did the Examiner err in rejecting claims 8-10, 12, 13, 24-26, and 28, as being obvious because Orus fails to teach or suggest personal preference data as set forth in representative claim 8, and similarly recited in remaining independent claim 24?

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' contentions that the Examiner has erred in the Appeal Brief (App. Br. 8-9) and the Reply Brief (Reply Br. 1-5). Further, we have reviewed the Examiner's response to each of the arguments.

We disagree with Appellants' conclusion that the Examiner erred in finding that Orus teaches storing personal preference data on a smart card. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief (Ans. 3-20). We highlight and address specific findings and arguments for emphasis as follows.

Obviousness Rejection of Claims 8, 12, 13, 24, 26, and 28

We agree with the Examiner (Ans. 7-8 and 19-20) that Orus teaches a gaming method including storing a player's personal preference data on a portable smart card (Orus, ¶¶ [0012], [0049], [0054], and [0078]). We agree with the Examiner that any of the following meet the personal preference data limitation found in claims 8 and 24: (1) Orus' card balance and/or gambler's information found in paragraph [0012] (Ans. 8 and 19); (2) Orus' "information corresponding to the *credit desired by the gambler*" as described in paragraph [0049] (emphasis added) (Ans. 19-20); (3) "*information on the gambler, for example his age, gambling habits* for gambler loyalty applications, awarding free games, etc." as described in paragraph [0054] (emphasis added) (Ans. 20); and/or (4) "identification data such as identification number Id, several authentication keys Kta, Ktb, and Ktc, and possibly *information on the gambler*" as described in paragraph [0078] (emphasis added) (Ans. 7).

We also agree with the Examiner that Soltesz does not indicate that the method disclosed in Soltesz *cannot* be used in gaming machines since Soltesz discloses using the biometric smart card described in paragraph [0004] for use with transactions such as "airline ticketing, drivers license

renewals, vending, Internet or telephone system access, *and so forth*, with on-site verification and/or authentication of the user being carried out in real time using biometrics such as fingerprint or voice analysis" (Ans. 15 (emphasis added) (citing Soltesz at paragraph [0003])).

Appellants' argument that there is no motivation for making the combination is not persuasive in light of Soltesz's disclosure of using biometric smart cards, and Orus' disclosure of keeping track of winnings and players' data on a portable smart card. Instead, we agree with the Examiner (Ans. 5-8 and 15-17) that one of ordinary skill in the art would be motivated to combine Soltesz's biometric measuring and reading methods with Orus' application of portable smart cards to the gaming arena.

In view of the foregoing, Appellants have not sufficiently shown that the Examiner erred in rejecting representative claim 8 under 35 U.S.C. § 103(a) over Orus and Soltesz. Accordingly, we will sustain the obviousness rejection of representative claim 8, as well as claims 12, 13, 24, 26, and 28, based upon the combined teachings and suggestions of Orus and Soltesz.

Obviousness Rejection of Claims 9 and 10

Appellants have not presented any separate arguments with respect to the rejection of claims 9 and 10 as being obvious under 35 U.S.C. § 103(a) over Orus, Soltesz, and Thompson. As such, Appellants have not argued that the Examiner erred in rejecting claims19 and 10, or otherwise shown the obviousness rejection to be in error. *See* 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, we will sustain the Examiner's rejection of claims 9 and 10 on the same basis we sustained the rejection of as claim 8 from which claims 9 and 10 depend.

Obviousness Rejection of Claim 25

Appellants have not presented any separate arguments with respect to the rejection of claim 25 as being obvious under 35 U.S.C. § 103(a) over Orus, Soltesz, and Nakata. As such, Appellants have not argued that the Examiner erred in rejecting claim 25, or otherwise shown the obviousness rejection to be in error. *See* 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, we will sustain the Examiner's rejection of claim 25 on the same basis we sustained the rejection of as claim 24 from which claim 25 depends.

CONCLUSIONS

(1) The combination of Orus and Soltesz teaches or suggests the argued limitations of claims 8 and 24 on appeal.

(2) The Examiner has not erred in rejecting claims 8-10, 12, 13, 24-26, and 28 as being unpatentable under 35 U.S.C. § 103(a).

(3) Claims 8-10, 12, 13, 24-26, and 28 are not patentable.

DECISION

The Examiner's rejections of claims 8-10, 12, 13, 24-26, and 28 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

msc